REMARKS

Claims 1-25 were pending in this application.

Claims 1-25 have been rejected.

Claims 1, 11, and 21 have been amended as shown above.

Claims 1-25 remain pending in this application.

Reconsideration and full allowance of Claims 1-25 are respectfully requested.

I.   AMENDMENTS TO SPECIFICATION

The Office Action requests that the Applicants provide serial numbers for ten related patent applications. The Applicants have amended the specification to provide the serial numbers for the related applications.

II.   REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1, 3, 4, 8-11, 13, 14, 18-22, 24, and 25 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,680,564 to Divivier et al. (*"Divivier"*). This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP § 2131; In re Bond, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)*). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP § 2131; In re Donohue, 766 F.2d 531,*

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534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Divivier recites a method and apparatus for prefetching instructions in a pipelined processor. (*Abstract*). A first prefetch buffer and a second prefetch buffer are arranged in a two-tier system. (*Abstract*). Instruction bytes fetched from a cache memory or an external memory are loaded into the first prefetch buffer and/or the second prefetch buffer. (*Abstract*). Instruction bytes in the first prefetch buffer are provided to a decode stage in the pipelined processor. (*Col. 2, Lines 25-29*).

Claims 1 and 11 have been amended to recite that a controller is capable of using a "stop bit" in a "highest syllable" of an instruction to "determine whether every syllable of the instruction has been stored in the first buffer." Claim 21 has been amended to recite transferring at least one syllable "in response to determining that every syllable" of an instruction has been "stored in the first buffer using a stop bit in a highest syllable of the instruction."

The Office Action has not shown that *Divivier* recites these elements of Claims 1, 11, and 21. In particular, the Office Action has not shown that *Divivier* recites using a "stop bit" in a "highest syllable" of an instruction to determine whether or when "every syllable" of the instruction has been stored in a buffer.

Divivier does recite that each byte in the first and second prefetch buffers are associated with a "valid tag bit." (*Col. 5, Lines 27-28*). A "valid tag bit" identifies whether the byte in the corresponding byte position of a buffer is valid. (*Col. 5, Lines 28-31*). However, the Office Action has not shown that the "valid tag bits" of *Divivier* anticipate a "stop bit" in a "highest syllable" of an instruction or that the "valid tag bits" are used to determine whether or when

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"every syllable" of the instruction has been stored in a buffer as recited in Claims 1, 11, and 21.

As a result, the Office Action has not established that *Divivier* anticipates all elements of Claims 1, 11, and 21.

For these reasons, the Office Action does not show that *Divivier* anticipates the Applicants' invention as recited in Claims 1, 11, and 21 (and their dependent claims). Accordingly, the Applicants respectfully request withdrawal of the § 102 rejection and full allowance of Claims 1, 3, 4, 8-11, 13, 14, 18-22, 24, and 25.

III.   REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 2, 5-7, 12, 15-17, and 23 under 35 U.S.C. § 103(a) as being unpatentable over *Divivier*. This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then

without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As described above in Section II, the Office Action does not establish that *Divivier* discloses, teaches, or suggests various elements of Claims 1, 11, and 21. As a result, the Office Action has not shown that *Divivier* discloses, teaches, or suggests all elements of Claims 2, 5-7, 12, 15-17, and 23.

Accordingly, the Applicants respectfully request withdrawal of the § 103 rejection and full allowance of Claims 2, 5-7, 12, 15-17, and 23.

IV.   <u>CONCLUSION</u>

As a result of the foregoing, the Applicants assert that all pending claims in the application are in condition for allowance and respectfully request an early allowance of such claims.

SUMMARY

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Applicants respectfully invite the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com.*

The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: _July 12, 2004_

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